

### REMARKS

In the Office Action mailed December 7, 2005, the Examiner rejected claims 21-23, 25-27, 29-32, 34-36, 38-42, 44 and 45 and objected to claims 24, 28, 33, 37 and 43, but indicated claims 24, 28, 33, 37 and 43 as allowable if rewritten in independent format. Applicants thank the Examiner for the indication of allowable subject matter. By way of the foregoing amendments and the markings to show changes, Applicants have amended claims 21, 38, 39 and 40 canceled claims 28 and 40 and added new claims 46-49. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

#### I. Drawings

The Office Action objected to the drawings suggesting that, "the mechanical fastener or an adhesive of claim 21 and the pillar of claim 33 must be shown or the features canceled..." In response to the first suggestion, Applicants have amended the specification and drawings (replacement sheet submitted herewith) to include reference numeral 37 indicating the mechanical fastener or adhesive. In response to the second suggestion, Applicants reproduce a paragraph from the specification showing how the pillar is illustrated. That paragraph is as follows:

For assembling the reinforcement member to an article of manufacture, reference will be made to Figs. 4-10. In Figs. 4-10, the reinforcement member 10 is illustrated as it is assembled to a structure 14 of an automotive vehicle, although the skilled artisan will recognize that the reinforcement member 10 taught by the present invention may be applied to a variety of articles. The structure 14 is illustrated as a D-pillar of the automotive vehicle, but again, it shall be recognized that the reinforcement member may be applied to various structures of the automotive vehicle such as A, B, or C-pillars, frame structure, body structures, roof assemblies, bumpers, closure devices or the like.

#### II. Rejections under 35 USC 102 and 103

The Office Action rejected claims 21-23, 25-27, 29-32, 34-36, 38-42, 44 and 45 under 35 USC 102 and/or 103 as being anticipated or obvious in view of one or

more of the following references: Blank (6,519,854); Hopton et al (6,253,524); Barz et al (6,311,452); and Barz et al. (6,467,834), but indicated claims 24, 28, 33, 37 and 43 as allowable if rewritten in independent format. Applicants have rewritten claim 21 to be claim 28 in independent form and, as such, claim 21 is now allowable. Applicants have also amended claim 39 and believe that claim 39 is patentable over the references of record below. Applicants traverse the rejections of claim 32 and its dependents with particularity below.

Pursuant to MPEP 2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Pursuant to MPEP 2143.03, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Court of Appeals for the Federal Circuit, in the case of In re Lee, 61 USPQ2d 1430 (CAFC 2002), wrote:

The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'" (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");... The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled

artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

Furthermore, the MPEP reads, at section 2143.01, that, "Obviousness can only be established by combining or modifying the teachings of the prior art to the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

#### A. Rejections under 35 USC 102

Applicants contend that the Office Action has failed to establish a prima facie case of anticipation of at least claims 32 and 36 since the Office Action has failed to show that Barz '834 shows each and every element of those claims.

#### Claim 32

The Office Action suggests, in regard to claim 32, that, "Barz et al. '834 disclose the claimed invention including a locating member (or end panel, not numbered but best seen in Figure 8) which includes a panel that overlays a surface of a reinforcement member ... [and the] locating member functions as a baffle and physically substantially separates portion of the cavity from each other."

Applicants, in contradiction to the suggestion of the office action, contend that Barz et al. '834 discloses that which is actually discussed in reference to Figures 6-8. In particular, Barz et al. '834 reads, at column 4, lines 7-17, "... and referring now to

FIGS. 6 through 8 of the drawings, composite reinforcement 70 is in the nature of a ring or continuous wall structure. Each face 72 has a channel 74 into which a resin strip 76 is disposed ...” In contrast to this, claim 32 recites, “a reinforcement member... including a carrier member formed as a shell” and “at least one locating member attached to the reinforcement member, the at least at least one locating member assisting is locating the reinforcement member within the cavity of the structure wherein the at least one locating member includes a panel that overlays a surface of the reinforcement member.” Applicants assert that the Office Action has not properly shown how Barz et al. '834 shows one or more of these particular features recited in claim 32. As such, Applicants contend that the Office Action has failed to establish a prima facie case of anticipation against claim 32. Applicants request that any rejections of claims 32 and its dependents be withdrawn.

#### Claim 36

Claim 36 recites, “...wherein the carrier member is formed of a molding compound selected from sheet molding compound, bulk molding compound and thick molding compound.” In rejecting claim 36, the Office Action asserts merely that, “the carrier member is preferably formed from injection molded plastics.” Applicants contend that “injection molded plastics” would not anticipate a molding compound selected from sheet molding compound, bulk molding compound and thick molding compound as those terms would be understood by the skilled artisan. Applicants therefore request that the rejection of claim 36 be withdrawn.

#### B. Rejections under 35 USC 103

Applicants contend that the Office Action has failed to establish a prima facie case of obviousness against at least claim 34 of the present application. Applicants first note that obviousness of claim 34 has not been established for the same reasons that anticipation has not been established for claim 32 (i.e., the Office Action has not shown all the elements of claim 32 in the prior art or the general knowledge of the skilled artisan). In addition, the Office Action has failed to provide a motivation to combine Blank with Barz '834 sufficient to maintain the asserted obviousness rejection of claim 34.

The Office Action suggests that, "It would have been obvious ... to have provided sealant material as taught by Blank upon the locating member of Barz et al. '834 in order to further encapsulate the reinforcement member within the structure and thereby strengthen the structure." The Office Action also identifies pyramid 66 of Blank as being a locating member. Applicants contend, however, that it is not clear that the material upon pyramid 66 is a sealing material or is designed to perform a sealing function. More significant, however, there is no real suggestion by the Office Action, that the cited references or the knowledge of the skilled artisan suggest that a sealing material upon a locating member would increase reinforcement to any significant degree or that the skilled artisan would consider such an effect particularly desirable for the member of Barz et al '834. As such, Applicants contend that the Office Action fails to establish obviousness of claim 34 and request that the rejection of claim 34 be withdrawn.

Lastly, Applicants contend that it would likely be improper to present a final rejection of current claim 32 and its dependents on a grounds alternative to that already presented for those claims since applicants have not amended those claims in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." MPEP 706.07(a)

Thus, any new grounds of rejection, "that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." would be improper.

### III. New Claims

Applicants have added new claims 46-49 to address various aspects of the present invention and believe that claims 46-49 are patentable over the references of record.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

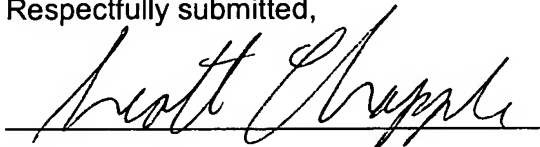
### **CONCLUSIONS**

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

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Respectfully submitted,



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